UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,545	04/14/2000	Shawn Scotzin	2635-020-03 (RN23)	8286

72455 7590 02/04/2009

Graybeal Jackson Haley c/o RealNetworks
Graybeal Jackson Haley LLP
155 - 108th Ave NE Suite 350
Bellevue, WA 98004-5973

EXAMINER	
FLANDERS, ANDREW C	
ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
02/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/550,545	SCOTZIN ET AL.	
	Examiner	Art Unit	
	ANDREW C. FLANDERS	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *91-110* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *91-110* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 26 November 2008 have been fully considered but they are not persuasive.

Applicant states:

> However, if after considering this response the Examiner does not allow all of the claims, the Applicants" attorney requests that the Examiner contact him to schedule a telephone interview to further the prosecution of this application.

Applicant's request for an interview is hereby denied. Examiner has determined an interview will not advance prosecution. Two interviews were previously held in this application and did not further prosecution.

Applicant alleges:

> "Neither Lau nor Li, alone or in combination, disclose or render obvious the limitations of claim 91. As the Examiner acknowledged on page 4 of the Office Action in this matter mailed May 28, 2008 ("the Office Action"), Lau does not disclose determining whether the format of a music track is compatible with a corresponding music renderer such that the music renderer can render music from the music track and, in response to a determination that the format is not compatible with the music renderer, reformatting the music track to a format that is compatible with the music renderer."
>
> "Li does not provide the missing disclosure. First, Li does not disclose determining whether the format of a music track is compatible with a corresponding music renderer such that the music renderer can render music from the music track. Referring, e.g., to column 6 lines 3-29, Li teaches a system wherein multimedia web content is optimized for delivery to a client device based upon that device's "capabilities" and "resources." "Capabilities" are defined by Li as the ability for the client

> device to handle a particular media type. If, for example, a device lacks an audio speaker, it has no capability to render music from a music track regardless of format. "Resources" include parameters of the device such as screen size, network bandwidth, storage capacity, wait time and payment ability. "

Examiner disagrees. The capabilities determined by Li are not merely determining whether or not a speaker is attached. This is one example of the capabilities, but an over simplification of what the capabilities are. Some other capabilities include (ii) audio capability, or (v) software such as decompression; col. 6. This at least suggests some level of determination as to whether a media item can be decompressed.

Furthermore, Examiner is unsure where Applicant has found the example of the audio capability being whether a device lacks a speaker. The citation provided, e.g. col. 6 lines 3 - 29 do not explicitly state this. This appears to be an interpretation by the Applicant that is not supported in the text provided.

Applicant further alleges:

> Although Li discloses optimizing media content based on those resources, it does not teach determining whether the format of a music track is compatible with the device-- only whether the device can render audio at all, and whether optimization of a particular audio object is needed based on bandwidth or processor concerns. The fact that a large MP3 file should be optimized by additional data compression in order to satisfy bandwidth concerns of the client device does not implicate whether that the client device is actually "compatible" with MP3-formated audio files.

Examiner disagrees. In addition to the reasons stated above, Li clearly shows a determination of capabilities, one being video decompression (which at least

suggests/makes obvious an audio decompression capabilities, as the device can reproduce audio). Further, the optimization is a form of compatibility, contrary to Applicant's allegation. If the data is not optimized, it may not be reproduced correctly, and thus can be considered to be "not compatible" with the device.

Applicant further alleges:

> Furthermore, Li does not disclose reformatting the music track to a format that is compatible with the music renderer in response to a determination that the format is not compatible with the music renderer. On pages 3-4 of the instant Advisory Action, the Examiner asserts that "compressing an audio file" changes the "format" of the audio file. Applicants' attorney respectfully suggests that this is a misapprehension of the term "format" as used within the present application, as well as its common usage and the understanding of one of ordinary skill in the relevant art. For example, referencing the attached Wikipedia articles "Audio Format" and "Audio File Format" as viewed on November 18, 2008, it is clear that the term "format" as applied to digital audio storage refers to a particular audio encoding scheme or file type. 1 Instances of these formats include but are not limited to MPEG Level-3 ("MP3"), WAV, WMA, AIFF, FLAC, and AAC. The majority of these audio formats support multiple encoding parameters, such as bit rate, number of channels (mono or stereo), or sampling rate. However, one of ordinary skill in the art will appreciate that transcoding an MP3 audio file having a 320k bit rate into an MP3 audio file having a 128k bit rate does not result in an audio file with a different "format." Both files comply with the MP3 "format" and simply possess different encoding parameters.

Examiner respectfully disagrees. One narrow definition provided by Applicant of "format" would, indeed, overcome the rejection. However, format can also be broadly described as in the Microsoft Computer Dictionary as "In general, the structure or appearance of a unit of data." In the instant allegation, compression would change the structure or appearance of the unit of data, and thus change the format of the audio.

Additionally transcoding from a 320k bit rate to a 128k bit rate again changes the structure of the unit of data, and thus changes the format. Format is not narrowly defined as a type of compression as alleged by Applicant.

Applicant further alleges:

> Referring to column 5 lines 27-62, Li discloses a number of possible changes to media objects. For audio objects, leaving aside the modality change involved in "speech recognition," these changes are specifically limited to adjusting resolution-- "bit-rate reduction, sampling rate change, stereo to mono." Describing these changes in resolution as a change in "format" as applied to digital audio storage is inconsistent with common usage (as evidenced by the above-referenced Wikipedia articles), with the specification of the present application, and with the Li reference itself, which does not purport to alter the format of an audio file. As further evidence of the common but specific usage of the term "format," Applicants' attorney notes that on page 3 of the instant Advisory Action, the Examiner himself describes the compression and format of an audio file as two distinct qualities when he states that "its reproduction/decompression procedure differs depending upon its compression or format." Changing the compression or compression parameters of a file does not change the format of the file.

Examiner disagrees. Common usage of the term format is not as narrowly defined as Applicant suggest. This is further evidenced by the Microsoft computer dictionary definition of Format.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 91 – 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau (U.S. Patent 6,772,212) in view of Li (U.S. Patent 6,345,279).

Regarding **Claim 91**, Lau discloses:

An electronic device for communication with a user (i.e. computer system; Fig. 1) comprising:

circuitry that includes a processor (processor; Col. 4); and

a set of software instructions that (any of the software to run the system or produce the GUI shown in the figures), when executed by the processor, causes the circuitry to:

display a graphical user interface that includes a library (1202, 1204 and 1206) and that graphically depicts music renderers (Fig. 13 element 1202 which lists the devices that can be communicated with to store tracks) .

Lau does not explicitly disclose that the library is a hierarchical library tree or the music renderers are depicted as nodes.

However, graphical user interfaces for transferring music between portable devices (and non portable devices) are notoriously well known to be shown in a hierarchical format. For example Katz (US 6,356,971) shows a computer with a windowed GUI that includes a main PC connected to remote music devices (Figs. 4A - 4D). Dweyer (US 6,671,567) shows another hierarchical windowed GUI on a computer communicating with a portable audio storage and playback device (Fig 8). Further, the Windows Operating System includes the explorer program which typically shows the various storage devices one can use to store information or manipulate/move.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lau's displays (1202, 1204, 1206) to display as a hierarchical library. One would have been motivated to do so to provide an easier to operate GUI. Hierarchical trees showing files and allowing manipulation have been implemented in

systems very widespread (such as MS Windows). As a result user's are familiar with the hierarchical format and thus the device would be easier to use.

The modification further discloses:

wherein the music renderer node identifies a music renderer coupled to the device and (displaying the connected devices in 1202) and includes information about the music renderer (the device connected can be edited, thus indicating that information must be provided to the computer system in order for editing to occur; editing shown in col 13), and the music item node includes an icon identifying a music track stored on the medium of the device (the tracks presented in 1206; also col. 13).

The modification of Lau does not disclose the remaining limitations of claim 91.

In a similar field of endeavor (media transferring between computer devices) Li discloses a system that includes a device that provides capability information to a server device which then is able to transcode the media data to a format acceptable to the device; Fig. 3).

Applying this to the invention disclosed by Lau teaches:

in response to moving the icon from the music item node to the music renderer node (i.e. dragging music files; col. 13), the circuitry

determines whether the format of the corresponding music track is compatible with the corresponding music renderer such that the music renderer can render music from the track (connecting a playback device {such as the one taught by Dweyer example only, many possible} to the computer system, the client profile 310 of the

device as modified by Li is provided to the system, which shows the capabilities and resources of the device; col. 6 of Li),

in response to a determination that the format is not compatible with the music renderer, reformats the music track to a format that is compatible with the music renderer; and moves the music track to the music renderer (i.e. Li teaches a content adaptation process 350 uses the profile to select the version of the media that best satisfies the particular client profile, the client, which is the device of Lau, then receives the customized media; col. 6 of Li).

It would have been obvious to one of ordinary skill in the art to apply the teachings of Li to the device taught by Lau. Lau recognizes that multiple devices may be connected to the system. Li recognizes that there exists a wide range of devices that can provide media content to user. These device contain numerous properties and it would be desirable to optimally match the media to the capabilities of the client device requesting it; cols. 1 and 2.

Regarding **Claim 92**, in addition to the elements stated above regarding claim 91, the combination further discloses:

an input device comprising at least one of a keyboard, a roller ball, a pen, a stylus, a touch screen, a microphone and a mouse (i.e. inputs to the device such as the pointing device or keyboard).

Regarding **Claim 93**, in addition to the elements stated above regarding claim 91, the combination further discloses:

wherein the hierarchical library tree graphically depicts more than one music renderer node, wherein each music renderer node identifies a respective one of a plurality of music renderers coupled to the device (the devices of 1202 in Lau as displayed in the hierarchical fashion; multiple devices can be connected to the system of Lau; col. 13).

Regarding **Claim 94**, in addition to the elements stated above regarding claim 91, the combination further discloses:

wherein the music renderer nodes represent at least one of a stationary device, a stereo system, a portable device, a Diamond RIO, a RCA Lyra, a portable radio, and a personal display adapter (i.e. a portable device as the hard disk in Lau or the portable device as shown by Dweyer example only, many possible).

Regarding **Claim 95** in addition to the elements stated above regarding claim 92, the combination fails to explicitly disclose in response to moving the icon from the music item node to the music renderer node, the circuitry copies the music track before moving the music track.

However, it is notoriously well known in the art to wait to display a moved item until it is completely copied (i.e. functionality of windows explorer). This is often done to prevent file systems from being corrupted and displaying incorrect information if an error

occurs during the transfer process. It would be desirable to add these features to the combination for the same benefits.

Claims 96 – 101 claim the same limitations as claims 91—95 above and are rejected under the same grounds.

Regarding **Claim 102**, in addition to the elements stated above regarding claim 91, the combination further discloses:

wherein the music item node includes more than one icon each identifying a respective one of a plurality of music tracks stored on a storage medium of the device (music tracks 1206 as displayed by a hierarchical tree in the modification).

Regarding **Claim 103**, in addition to the elements stated above regarding claim 91, the combination further discloses:

wherein the hierarchical library tree graphically depicts more than one music item node, wherein each music item node includes an icon identifying a respective one of a plurality of music tracks stored on a storage medium of the device (music tracks 1206 as displayed by a hierarchical tree in the modification).

Regarding **Claim 104**, in addition to the elements stated above regarding claim 91, the combination further discloses:

wherein the circuitry stores the moved music item in the music renderer (storing tracks to the disk via the cartridge; Fig. 1; or portable devices in the examples shown above).

Regarding **Claim 105**, in addition to the elements stated above regarding claim 96, the combination further discloses:

wherein displaying the graphical user interface includes displaying more than one music renderer node, wherein each music renderer node identifies a respective one of a plurality of music renderers coupled to the device (devices 1202 as displayed by a hierarchical tree in the modification).

Regarding **Claim 106**, in addition to the elements stated above regarding claim 96, the combination further discloses:

wherein displaying the graphical user interface includes displaying more than one icon in the music item node, each icon identifying a respective one of a plurality of music tracks stored in the device (music tracks 1206 as displayed by a hierarchical tree in the modification).

Regarding **Claim 107**, in addition to the elements stated above regarding claim 96, the combination further discloses:

wherein displaying the graphical user interface includes displaying more than one music item node, wherein each music item node includes an icon identifying a

respective one of a plurality of music tracks stored in the device (music tracks 1206 as displayed by a hierarchical tree in the modification).

Regarding **Claim 108**, in addition to the elements stated above regarding claim 96, the combination further discloses:

further comprising storing the moved music track in the music renderer (storing tracks to the disk via the cartridge; Fig. 1; or portable devices in the examples shown above).

Regarding **Claim 109**, in addition to the elements stated above regarding claim 101, the combination further discloses:

in response to moving the icon from the music item node to the music renderer node, the program further causes the computer to copy the music track (dragging via the interface; storing tracks to the disk of the computer via the cartridge; Fig. 1; or portable devices in the examples shown above).

Regarding **Claim 110**, in addition to the elements stated above regarding claim 101, the combination further discloses:

in response to moving the icon from the music item node to the music renderer node, the program further causes the computer to store the music track in the music renderer (dragging via the interface; storing tracks to the disk via the cartridge; Fig. 1; or portable devices in the examples shown above).

Conclusion

This is a request for continuation of applicant's earlier Application No. 09/550,545. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case.

See MPEP § 706.07(b), specifically The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW C. FLANDERS whose telephone number is (571)272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C Flanders/
Patent Examiner
Art Unit 2614

/CURTIS KUNTZ/
Supervisory Patent Examiner, Art Unit 2614